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In re application of

Miho et al.

Serial No. 10/632,746

Filed: August 1, 2003

For: IMAGE FORMING APPARATUS AND
TONER USED THEREIN

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: DECISION ON
: PETITION
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This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION, dated January 20, 2006.

On January 10, 2005, a non-final Office Action was mailed to Applicants. The Office Action contained a 112 second paragraph rejection of Claims 1 and 15 and a rejection under 35 USC 103 of Claims 1-25 over Ogawa and Thompson in view of Nishikiori.

A reply to the Office Action was filed on April 7, 2005. In the reply, Applicant amended Claims 1 and 15. The amendments to Claims 1 and 15 overcame the 35 USC 112 second paragraph rejection.

On December 13, 2005, a Final Office Action was mailed. All of the previous grounds of rejection were withdrawn. New grounds of rejection were added which included a 35 USC 102 (e) rejection of Claims 1-25 over newly cited art to Suzuki; a 35 USC 102(b) or alternatively a 35 USC 103 rejection of Claims 1-25 over newly cited art to Baba; a 35 USC 103 rejection of Claims 1-25 over newly cited art to Suzuki in view of Baba; and 35 USC 112 rejections of Claims 1, 5 and 19. The Examiner stated in the Final Office Action that the new grounds of rejection were necessitated by Applicant's amendments to the claims. On January 20, 2006, the present petition was filed.

Petitioner has argued that the finality of the last Office Action is improper in that Applicant's amendments did not change the scope of the claims but rather changed an unnecessary verbose description of the invention to a more direct recitation. Petitioner argues that the Examiner misinterpreted the claim.

DECISION

Section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted

in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Claim 1 examined in the Non-Final Office Action recited,

“wherein the developing means performs development using toner in which, out of five materials of silica, titania, barium sulfate, fine polymer particles, and a lubricant, materials not including either the fine polymer particles or the barium sulfate are fixed as an external additive.”

Amended Claim 1 examined in the Final Office Action recited,

“wherein the developing unit performs development using toner on which materials of silica, titania, a lubricant and either fine polymer particles or the barium sulfate are fixed as an external additive.”

Claim 15 examined in the Non-Final Office Action recited,

“wherein materials for an external additive which is fixed on a surface of the toner includes, out of five materials of silica, titania, barium sulfate, fine polymer particles, and a lubricant, four materials not including either the fine polymer particles or the barium sulfate.”

Amended Claim 15 examined in the Final Office Action recited,

“wherein materials as an external additive which is fixed on a surface of the toner include silica, titania, a lubricant, either fine polymer particles or barium sulfate.”

The amendments to Claims 1 and 15 overcame the 35 USC 112 rejection of the Non-Final Office Action.

Petitioner argues that the amendments to Claims 1 and 15 did not change the scope of the claims but rather changed an unnecessarily verbose description of the invention as presented in Claims 1 and 15 to a more direct recitation, that the original description used toner where out of five materials only materials which did not include fine polymer particles or did not include barium sulfate were used, that the Examiner mis-interpreted the claims as requiring all five materials be present which ignores the recitation “not including either the fine polymer particles or the barium sulfate”, and that the intended invention to be claimed was to be the second toner and the third toner as described on page 13 of the Specification where the second toner does not contain fine polymer particles and the third toner does not contain barium sulfate.

These arguments are not persuasive. The amendments to the claims as set forth above do change the scope of the claims. As a result of the unclear claim language in Claims 1 and 15, the Examiner correctly rejected the claims under 35 USC 112, second paragraph, and clearly stated in the Non-Final Office Action a reasonable interpretation of the unclear claim language for examination purposes. The amendments to the claims both clarified the claim language in Claims 1 and 15 which caused the 35 USC 112 rejection and changed the scope of the claims by no longer requiring five

materials to be present with only four materials externally fixed. It is noted that the original disclosure does disclose an embodiment where all five materials are present. While Petitioner argues that the Examiner mis-interpreted the claims to include all five materials, such "mis-interpretation" is directly caused by the indefiniteness of the original claim language. It would not have been reasonable to expect the Examiner to predict that it was Applicant's intention to claim only the second and third embodiments disclosed in the Specification without clear indication from the claim language.

Accordingly, the examiner properly made the December 13, 2005 Office Action Final. The Petition is **DENIED**.



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